

ICH 286

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rolf STEIGER

Serial No.: 09/336,462

Filed: June 18, 1999

Group Art Unit: 1774

Examiner: M. Grendzynski

Date: May 8, 2002

For: RECORDING SHEETS FOR INK JET PRINTING

\$72.9310

BY FACSIMILE 703-369-5408

Assistant Commissioner for Patents
Washington, D.C. 20231REQUEST FOR THE WITHDRAWAL OF NOTICE OF ABANDONMENT

Dear Examiner Grendzynski:

Applicants submit this request for Withdrawal of the Notice of Abandonment to revive the above-identified patent application.

A Notice of Abandonment was mailed in the above-identified application on March 26, 2002 (copy annexed as Exhibit 1), for failure to submit a proper reply to the office action mailed on June 15, 2001¹. Applicants submit that this Notice was sent in error.

An Amendment along with authorization to charge extension fees was timely submitted by the Applicant's on December 10, 2001.

The USPTO acknowledged receipt of the Amendment as evidenced by the return receipt postcard stamped by the USPTO on January 7, 2002.

In fact the USPTO even charged the extension fee of \$920 to my deposit account 50-1541 on February 6, 2002.

Copies of the Amendment documents and USPTO deposit account are annexed hereto as Exhibit 2.

Thus, a proper response was timely filed prior to the deadline of December 15, 2001 and the Notice of Abandonment was issued in error.

Accordingly, Applicants respectfully request that the Notice of Abandonment be withdrawn and the Amendment be entered into the record.

If you have any questions concerning the above please do not hesitate to contact the undersigned.

¹ Applicants recently received this Notice of Abandonment. It is brought to the Examiner's attention that the Notice was sent to the attorney of records old office address at 233 Broadway - Suite 2702, NY, NY 10279. Our new office address has been filed with the USPTO and is listed herein at the end of this paper.

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Respectfully submitted,

Attorneys for Applicant's

By:

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being transmitted to the United States Patent Office on the date shown below addressed to the:

Assistant Commissioner for Patents,
Washington, D.C. 20231.

Attention: Examiner Michael E. Grendzynski

Dated: May 8, 2002

Dara L. Onofrio
Person mailing paper

Dara L. Onofrio
Signature of person mailing
paper



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,462	06/18/1999	ROLF STEIGER	ICH-286	7675

25230 7590 03/26/2002
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EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT PAPER NUMBER

1774

DATE MAILED: 03/26/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.


FAX RECEIVED
MAY 8 2002
GROUP 1700
OFFICIAL

Notice of Abandonment	Application No.	Applicant(s)
	09/336,462	STEIGER, ROLE
	Examiner	Art Unit
	Michael E. Grendzynski	1703

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

This application is abandoned in view of:

- ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 15 June 2001.
 - ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - ☒ No reply has been received.
- ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - ☐ The issue fee and publication fee, if applicable, has not been received.
- ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - ☐ No corrected drawings have been received.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:


 BRUCE H. HESS
 PRIMARY EXAMINER
 GROUP 1300

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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MONTHLY STATEMENT
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 To replenish your Deposit Account, detach and
 return top portion with your check. Make check
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 THE LAW OFFICES OF DARA L. ONOFRIO
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FINA

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Page	1

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MO.	DAY	YR.						
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2	5	02	107	09953641	IGB 1540 US	581	40.00	3060.00
2	6	02	1	09336462	ICH 286	122	130.00	2930.00
2	6	02	2	09336462	ICH 286	117	920.00	2010.00
2	6	02	3	09360886	ICH 284	122	130.00	1880.00
2	6	02	4	09360886	ICH 284	117	920.00	960.00
2	7	02	25	E-REPLENISHMENT		701	-1100.00	2060.00
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Rolf STEIGER

Group Art Unit: 1774

Serial No.: 09/336,462

Examiner: M. Grendzynski

Filed: June 18, 1999

Date: December 10, 2001

For: RECORDING SHEETS FOR INK JET PRINTING

Assistant Commissioner for Patents
Washington, D.C. 20231AMENDMENT

Sir:

This is responsive to the Office Action dated June 15, 2001, in the above-identified application.

Applicant has simultaneously, under separate cover, submitted with this Amendment a Petition under 37 C.F.R. 1.183 invoking Extraordinary Circumstances for Waiver of Extension Fees (in whole or part), or in the alternative, as a Petition for payment of extension fees for filing this response (see copy enclosed for your records).

IN THE CLAIMS

Please cancel claims 4, 6, 7 and 10 and amend claims 1, 5, 15, 18 and 19 as follows:

1. (Twice Amended). A recording sheet for ink jet printing comprising a support wherein at least one ink receiving layer is coated thereon and contains binders a porous inorganic oxide and an aliphatic hydroxycarboxylic acid with more than 2 C atoms, wherein said porous inorganic oxide is colloidal aluminum oxide, colloidal aluminum oxide/hydroxide or pseudo-bohemite and further includes at least one element of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71.

5. (Twice Amended) A recording sheet according to claim 1 wherein said porous inorganic oxide is colloidal γ -Al₂O₃.

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15. (Amended). A recording sheet according to claim 1 further comprising fillers selected from the group consisting of kaolin, talcum, Ca- or Ba-carbonates, silica, titanium dioxide, bentonite, zeolite, aluminum silicate, calcium silicate or colloidal silicium dioxide[,] and polymer beads [and other inorganic inert particles].

18. (Amended). A recording sheet according to claim 1 further comprising an auxiliary layer which includes [additional ink receiving layer, wherein said] a porous inorganic oxide and or an [said] aliphatic hydroxycarboxylic acid with more than 2 C atoms [are in separate layers].

19. (Amended). A recording sheet according to claim 1 wherein the coating on said support has a thickness in the range of 0.5 to 100 μ m dry thickness.

PLEASE ADD THE FOLLOWING NEW CLAIM

21. A recording sheet according to claim 1 further comprising fillers selected from the group consisting of inorganic inert particles.

REMARKS

All, claims pending, namely 1-9 and 11-20 stand rejected under indefiniteness, anticipation and obviousness grounds.

Claim 10 was subject to a restriction requirement and has now been canceled.

INDEFINITENESS REJECTIONS

Claims 5, 7, 8, 11, 15, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of

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the invention.

Claim 1 has been amended to incorporate the limitations of Claims 4, 6 and 7 which have now been canceled. Claim 1 now particularly defines the ink receiving layer as containing a binder, a porous inorganic oxide and an aliphatic hydroxycarboxylic acid with more than 2 C wherein the "porous inorganic oxide is colloidal aluminum oxide, colloidal aluminum oxide/hydroxide or pseudo-bohemite and further includes at least one element of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71."

Claim 5 has been amended to clarify the formula as " γ - Al_2O_3 ".

Applicant believes that the amendment made to Claim 1 clarifies the Examiner's objection to Claim 11, where it is now clear that the porous inorganic oxide includes at least one element of the rare earth metal series of the periodic system.

Claim 15 has been amended and new Claim 21 added to define the fillers as "inorganic inert particles".

Claim 18 as amended clearly defines an embodiment where an auxiliary layer is coated on top of the ink receiving layer. This auxiliary layer includes either a porous inorganic oxide or an aliphatic hydroxycarboxylic acid with more than 2 C atoms.

Claim 19 has been amended to claim the thickness in " μm ".

Applicant believes that the amendments to the claims are fully supported by the specification as originally filed and do not introduce new matter. Accordingly, all of the Examiner's indefiniteness rejections have been overcome and are respectfully requested that they be withdrawn.

ANTICIPATION REJECTION

Claims 1-3 and 15-18, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,589,277 to Malhotra and under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No.

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6,051,106 to Omura. Applicant respectfully disagrees.

It is axiomatic that "[f]or a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference." In re Bond, 910 F.2d 831, 832, 15 USPQ 1566, 1567 (Fed.Cir. 1990).

As discussed above, Claim 1 has been amended to particularly define the invention as "having at least one ink receiving layer". This layer contains binders, a porous inorganic oxide and an aliphatic hydroxycarboxylic acid with more than 2 C atoms. Unlike both Malhotra and Omura, the coated layer of the invention includes a porous inorganic oxide which is colloidal aluminum oxide, colloidal aluminum oxide/hydroxide or pseudo-bohemite and further includes at least one element of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71.

Therefore, neither Malhotra nor Omura contain every element of the present invention and thus are not anticipatory of the claims. Accordingly, the Applicant respectfully requests that the Examiner's anticipation rejections be withdrawn.

OBVIOUSNESS REJECTIONS

Claims 1-9 and 11-20 are rejected under 35 U.S.C. 103(a) as obvious over either U.S. Patent No. 5,589,277 to Malhotra or U.S. Patent No. 6,051,106 to Omura, in view of U.S. Patent No. 6,156,419 to Brugger. The claims also stand rejected as being unpatentable over Brugger in view of Malhotra.

The Examiner cites Malhotra as disclosing a recording sheet with at least one ink receiving layer similar to the invention layer but acknowledges that Malhotra does not "limit the type of filler pigment that is used in its sheet." The Examiner cites Brugger as teaching use of an aluminum oxide/hydroxide from 0.04 to 4.2 mole percent of one or more elements of the rare earth metal series of the periodic system of elements with atomic numbers 57 to 71 relative to Al₂O₃ in an ink jet recording sheet

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to provide a recording sheet with high ink absorption rates and excellent image quality. The Examiner's states that it would have been obvious to one of ordinary skill in the art to use the porous aluminum oxide/hydroxide or Brugger in the ink receiving substrate of Malhotra. Applicant respectfully disagrees.

It is well-settled that the mere fact that the prior art could be modified to form the invention would not make that modification obvious unless the prior art suggested the desirability of the modification. In re Laskowski, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989); In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). It is submitted that the cited art does not teach or suggest the desirability of modifying the recording sheets of Malhotra which are designed for rapid drying times and include an additive material (i.e. monomeric amino acids, monomeric hydroxy acids and mixtures), a latex binder, and optional antistatic agents, biocides and filler, in view of the secondary reference to Brugger which discloses a porous aluminum oxide/hydroxide.

Further the Brugger reference teaches an ink receiving layer containing only a binder and the porous aluminum oxide/hydroxide. There is no teaching or suggestion in Brugger for the inclusion of an aliphatic hydroxycarboxylic acid with more than 2 C atoms in the ink receiving layer. Thus it would not be obvious to one of ordinary skill in the art to combine the teaching of Malhotra with Brugger. Accordingly, Applicant respectfully requests Examiner's obviousness rejections to be withdrawn.

Claims 1-9 and 11-20 stand rejected as being unpatentable over Omura in view of Brugger. Applicant respectfully disagrees.

Omura is non-analogous art disclosing the production of a cast-coated paper comprising a pigment and water based binder. In fact Omura teaches away from the Brugger reference by specifically stating in the specification at Col. 2 line 34 on that "cast coated papers for ink-jet recording contain as the main pigment component a porous synthetic silica of large specific

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area, so that they absorb a great amount of release accelerating material to cause frequent paper break, thereby suffering a great drop in productivity, compared with cast-coated papers, using other pigments as their main component." Accordingly, there is no motivation to combine the teaching of Omura with the Brugger reference disclosure of a porous aluminum oxide/hydroxide. Therefore Applicant respectfully requests Examiner to withdraw his obviousness rejections.

Finally, the claims stand rejected as being unpatentable over Brugger in view of Malhotra. Applicant respectfully disagrees. For the reasons stated above there is no motivation to combine the teaching of Brugger with the Malhotra reference. The Brugger reference particularly defines an ink recording layer containing "at least one binder and a porous aluminum oxide/hydroxide" there is no suggestion for combining these components with the "monomeric amino acids, monomeric hydroxy acids or monomeric polycarboxyl compounds" disclosed in Malhotra. Accordingly, Applicant respectfully requests the Examiner's obviousness rejection to be withdrawn.

In view of the above amendments, the indefiniteness rejections and the prior art rejections have been overcome. None of the art disclose the invention as claimed which particularly define an ink recording sheet having at least one layer including a binder; a porous inorganic oxide which is colloidal aluminum oxide, colloidal aluminum oxide/hydroxide or pseudo-bohemite and further includes at least one element of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71; and an aliphatic hydroxycarboxylic acid with more than 2 C atoms. This combination of elements is neither taught nor suggested by the cited art.

Applicants submit that this application is now in condition for allowance. A clean copy of the amended claims in compliance with 37 CFR 1.121(c) are also enclosed. No new matter has been introduced by this Amendment. Reconsideration of this application

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and allowance of the pending claims are hereby requested,
particularly, Claims 1-9 and 11-20.

Respectfully submitted,
Attorney for Applicant

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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the:

Assistant Commissioner for Patents,
Washington, D.C. 20231.

Dated: December 10, 2001

Dara L. Onofrio
Person mailing paper

Signature of person mailing
paper

ICH 286 - CLEAN COPY - CLAIMS PENDING - 12/10/01

1. (Twice Amended). A recording sheet for ink jet printing comprising a support wherein at least one ink receiving layer is coated thereon and contains binders a porous inorganic oxide and an aliphatic hydroxycarboxylic acid with more than 2 C atoms; wherein said porous inorganic oxide is colloidal aluminum oxide, colloidal aluminum oxide/hydroxide or pseudo-bohemite and further includes at least one element of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71.
2. (Amended). A recording sheet according to claim 1 wherein said aliphatic hydroxycarboxylic acid with more than 2 C atoms is a water soluble monohydroxy monocarboxylic acid.
3. (Amended). A recording sheet according to claim 2 wherein said water soluble monohydroxy monocarboxylic acid is 2-hydroxypropionic acid.
4. (Canceled). A recording sheet according to claim 1 wherein said porous inorganic oxide is colloidal aluminum oxide or colloidal aluminum oxide/hydroxide.
5. (Twice Amended) A recording sheet according to claim 1 wherein said porous inorganic oxide is colloidal γ - Al_2O_3 .
6. (Canceled). A recording sheet according to claim 1 wherein said porous inorganic oxide is pseudo-bohemite.
7. (Canceled). A recording sheet according to claim 1 wherein said porous inorganic oxide is AlOOH or pseudo-bohemite; and further includes at least one element of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71.
8. (Amended). A recording sheet according to claim 7 wherein said pseudo-bohemite is prepared by hydrolysis of aluminum isopropoxide in the presence of the hydroxycarboxylic acid.
9. (Amended). A recording sheet according to claim 1 to wherein said binders are gelatine, polyvinyl alcohol or polyvinyl pyrrolidone or mixtures thereof.
10. (Canceled). Coating compositions for the preparation of ink receiving layers for recording sheets for ink jet printing according to claims 1 to 9.
11. A recording sheet according to claim 7 wherein said element is present in an amount of from 0.04 to 4.2 mole percent relative to Al_2O_3 .
12. A recording sheet according to claim 1 further comprising water soluble metal salts selected from the group consisting of alkaline earth metal salts and rare earth metal salts.

13. A recording sheet according to claim 12 wherein said rare earth metal salt is lanthanum nitrate.

14. A recording sheet according to claim 1 further comprising cross-linking agents.

15. (Amended). A recording sheet according to claim 1 further comprising fillers selected from the group consisting of kaolin, talcum, Ca- or Ba-carbonates, silica, titanium dioxide, bentonite, zeolite, aluminum silicate, calcium silicate or colloidal silicium dioxide and polymer beads.

16. A recording sheet according to claim 1 further comprising at least one or more of a compound selected from the group consisting of surfactants, brightening agents, UV absorbers, light stabilizers and antioxidants.

17. A recording sheet according to claim 1 wherein said porous inorganic oxide and said aliphatic hydroxycarboxylic acid with more than 2 C atoms are in the same layer.

18. (Amended). A recording sheet according to claim 1 further comprising an auxiliary layer which includes a porous inorganic oxide and or an aliphatic hydroxycarboxylic acid with more than 2 C atoms.

19. (Amended). A recording sheet according to claim 1 wherein the coating on said support has a thickness in the range of 0.5 to 100 μm dry thickness.

20. A recording sheet according to claim 1 wherein said support is coated with an antistatic layer or an anticurl layer on the uncoated support surface.

21. A recording sheet according to claim 1 further comprising fillers selected from the group consisting of inorganic inert particles